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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/625,145

07/22/2003

Stephen W. Boyd

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EXAMINER

NGUYEN, VI X

ART UNIT

PAPER NUMBER

3734

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/625,145	<b>Applicant(s)</b> BOYD, STEPHEN W.	
	<b>Examiner</b> Victor X. Nguyen	<b>Art Unit</b> 3734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 16 and 28-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16 and 28-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. The request filed on 5/12/2008 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 10/625,145 is acceptable and a RCE has been established. An action on the RCE follows.

#### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 16 and 28-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,3-4 and 11 of U.S. Patent No. 6,629,953. Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite the same subject matters as following: a device for removing material from a vascular site comprising: an expandable cage which has a plurality of openings in the expanded position, where the openings being formed by rigidly connected elements, a material removing element positioned within the cage. As to claims 28-33 are not patentably distinct from each other because they are essentially the same as those in the cited patent.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 16, 28-30 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Kleshinski (6,245,012).

Kleshinski discloses in figures 1, 3, a device for removing material from a vascular site having the limitations as recited in claims 16 and 28, including: a cage (10 or 40) has a plurality of openings (the openings occur at 18) and has an inner surface, the openings are formed by rigidly connected elements (16), where a sheath (34) is retractable relative to the cage to permit the cage to expand, and where a material removing element (14) positioned within the cage that is capable of removing the material extending into the openings, and where the material removing element is inherently movable along the inner surface of the cage to remove the material extending into the openings, where the cage is being releasable (see col. 6, lines 20-24) so the cage is able to be left within the patient. As to claims 29-30, where elements 16 can be deformed within an elastic range (these resilient wires can be interpreted broadly that these wires can be characterized as deformed within the elastic range of material when moving from the expanded position to the collapsed position. As to claim 33, where the cage forms 2-10 openings (see col.5, lines 32-47).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

*Claims 31-32 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Kleshinski in view of Fearnot (5,100,423).*

Kleshinski teaches all limitations substantially as claimed except a bag positioned to receive the material. Fearnot teaches the bag or net (see figure 8, element 202) in order to capture debris or matter from the bag or the filter. It would have been obvious to one having ordinary skill in the art at the time the invention to modify Kleshinski by adding the bag or the net as taught by Fearnot in order to capture debris or matter from the bag or the filter.

Claims 34-35 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Kleshinski (6,245,012)

Kleshinski discloses the invention substantially as claimed. Kleshinski is silent regarding the openings of the cage have a length of at least 1 mm and the openings of the cage have a size of at least 0.5 mm.

Regarding claims 34-35, the device could make the openings of the cage have a length of at least 1 mm and the openings of the cage have a size of at least 0.5 mm as best seen in fig.1. In the alternative, it has been held that changes in size only require routine skill in the art.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the device with the openings of the cage have a length of at least 1 mm and the openings of the cage have a size of at least 0.5 mm and a minor modification of Kleshinski's device would adopt the same for use under various conditions of service, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re. Aller, 220F, 2d 454, 105 USPQ 233.

### ***Response to Arguments***

5. Applicant's arguments filed 5/12/2008 have been considered but they are not persuasive. In response to applicant's argument that Kleshinski "does not suggest a material removing element which is movable along the inner surface of the cage to remove the material extending into the opening" (a functional limitation): It is noted that fig. 1 of Kleshinski can be defined element 14 as a material removing element which is inherently movable along the inner surface of the cage (see col. 4, lines 20-23, and 66-67, col. 5, lines 1-3). Thus, a reference needs not show the structure of the recitation in order to meet the claim language but rather the reference needs only be capable of being used with such structure. Furthermore, the applicant argues that Kleshinski reference fails to show certain feature of applicant's invention, it is noted that the feature upon which applicant relies (i.e., the stent extends over the mesh filter material rather than beneath the mesh material) is not recited **in the rejected claim(s) 16 and 28**. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d

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1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Accordingly, the above noted reference is still considered to read on the claimed limitations of the claims noted.

### *Conclusion*

6. This is a continuation of applicant's earlier Application No. 10/625,145. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ho Jackie can be reached on (571) 272-4697. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin T. Truong/  
Primary Examiner, Art Unit 3734

Victor X Nguyen  
Examiner  
Art Unit 3734

VN  
5/23/2008